

**Remarks/Arguments**

**The Rejection of Claims 2-11, 14-16, 19-22, 24-33, 36-38, and 41-44 Under 35 U.S.C. §103**

The Examiner rejected Claims 2-11, 14-16, 19-22, 24-33, 36-38, and 41-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) in view of U.S. Patent No. 5,991,751 (Rivette et al.) and further in view of U.S. Patent No. 6,401,206 (Khan et al.).

**Claim 11**

**Khan does not disclose a product document**

Claim 11 recites: “digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp.” The Examiner has cited col. 4, lines 45-63 and the Abstract of Khan as teaching the above claim limitation.

The Abstract and col. 4, lines 45-63 teach using a personal public identity with respect to electronically signing a document. Khan does not teach, suggest, or motivate the document being a product document. In fact, signing a product document makes no sense. An electronic signature would only be applicable to a personal communication of some sort, for example, a letter, legal document, or memo. Khan reinforces the teaching of the document being a personal communication in Figures 6 and 7, which show a Notary-Public key. Clearly, a Notary Public would have no function with respect to a product document.

**Khan does not digitally notarize a product document with a timestamp and a digital fingerprint**

As noted above, Khan does not teach, suggest, or motivate a product document. Therefore, Khan cannot teach notarizing a product document.

**Khan teaches against the invention recited in Claim 11**

Claim 11 recites a process whereby information regarding a product is introduced to the public by publishing a document including such information. Specifically, amended Claim 11 recites a publicly accessible database for this purpose. In stark contrast, Khan teaches: “This present invention is designed to enhance the exchange of *personal, confidential, legal and proprietary information* (emphasis added) reliably through electronic means.” (col. 1, lines 14-

16). Khan is teaching the polar opposite of what Claim 11 recites. The product document of Claim 11 is placed in a publicly accessible database and is meant to be disseminated to and viewed by the public. Confidential and proprietary information by definition cannot and is not made public. In virtually all cases, personal information is meant to remain non-public and typically, legal information also is kept confidential. “A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997).”

Rivette ‘677 does not teach the database and Web site of Claim 11

Claim 11 recites: “providing a searchable document database and a publication Web site in communication with a document database;”

Rivette is concerned with processing data. As stated in the first sentence of the Abstract: “A system, method, and computer program product for *processing* (emphasis added) data are described herein.” In the Summary of the Invention, Rivette further describes the invention as maintaining databases and groups, performing processing functions such as patent and document mapping, and having the ability to display hyperbolic trees. Rivette is silent regarding publication. Applicants performed a word search of Rivette and discovered that the word “publication” is not used in Rivette.

As well as failing to teach publication, Rivette also contains no suggestion regarding publication or the amended Claim 1 limitation that publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product. Rivette presents a synopsis of his invention in col. 10, lines 59-67:

The present invention is directed to a system, components of the system, a method, components of the method, and a computer program product for patent-centric and group-oriented data processing. Such processing includes, but is not limited to, reporting, analyzing, and planning.

The present invention is intended to aid a corporate entity in developing business-related strategies, plans, and actions. Accordingly, the present invention is also referred to herein as a business decision system and method.

The present invention is meant to be a very public and accessible process. That is, the goal of the present invention is to make a product document “sufficiently accessible to one skilled in the relevant art who exercise reasonable diligence” within the meaning of 35 U.S.C. §102(b). Hence, the present invention places publications in the public domain for purposes of establishing bars to patentability. On the other hand, Rivette is disclosing a system and method for internal use by a corporate entity as part of its decision-making process. This is the antithesis of a public and accessible process. Corporate viability and even survival require that business strategies and plans not be made accessible to competitors. Therefore, business entities go to great lengths to ensure the confidentiality and secrecy of meetings, documents, and data involved in decision-making/business plans. Thus, Rivette does not teach a Web publication site or include any motivation or suggestion regarding a Web publication site.

However, it should be noted that Claim 11 has been amended to specifically recite a publicly accessible database, which differentiates the database recited in Claim 1 even further from Rivette ‘767.

Donner does not teach receiving a product document

Claim 11 recites: “electronically receiving a product document transmitted by a client’s computer, where said product document provides information regarding a commercially available product;”

In general, Donner teaches retrieving data as in col. 5, lines 18-20: “Next, the data would be transmitted to a database access device 16 which would collect *various data* (emphasis added) from different on-line intellectual property databases 18.” In col. 6, lines 53-56 Donner states that a patent can be obtained using DIALOG. However, a patent is not analogous to a product document produced by a client. Further, Donner teaches receiving data or patents from a public database, for example, LEXIS, rather than a client’s computer.

The Examiner also states that Donner discloses the amended Claim 1 element of publishing a product document by adding the product document to a document database. Donner does not teach any type of publication, specifically publication for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said

product. The only documents that Donner teaches accepting are patents. Publishing a patent cannot establish a bar to patentability. The statutory bar presented by a patent is related to the priority date of the patent and is completely independent of any publication of the patent on a Web site. Assuming *arguendo* that documents other than patents were obtained by Donner, these documents would be obtained from a publicly accessible database. That is, a bar to patentability would already have been established by the presence of the document on a public database.

Further, Donner contains no motivation to publish a product document for purposes of establishing a bar date. Donner is describing an analysis tool, not a means of putting a document in the public domain, col. 4, line 66 to col. 5, line 9:

The intellectual property audit system according to the present invention may be used as an integrity check for acquisitions having assets involving a substantial intellectual property portfolio. The system could be used to compare the intellectual property portfolio to be acquired with other intellectual property portfolios having known market values to obtain an indicator of the intellectual property portfolio's worth. Depending on the quality of empirical data, the intellectual property audit system of the present invention could provide a qualitative and/or quantitative analysis of an intellectual property portfolio which is to be acquired.

Rivette '751 does not publish a document

Claim 11 recites: "publishing said product document by adding said product document to said document database, wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product;" The Examiner has cited Figure 2 from Rivette regarding this element, without specifying or substantiating the relevancy of the figure with respect to the above claim element. Rivette teaches processing data and contains no teaching, suggestion, or motivation regarding publication.

Regarding Figure 2, Rivette states: "The present invention processes patent information." "More generally, the present invention processes any documents, some of which are related to patents, and others which are unrelated to patents. These documents are preferably of interest to a business entity, and include contracts, licenses, leases, notes, commercial papers,

other legal and/or financial papers, etc., as well as patents.” “The present invention also **processes other information**, preferably business-related information, including (but not limited to) research and development (R&D) information 206, financial information 216, patent licensing information 214, manufacturing information 208, and other relevant business information 210 (which may, for example, include human resources information).” “The present invention is adapted to **maintain and process** massive amounts of documents (several hundred thousand or more).” “For example, a user 212 (who may be a business analyst) may be assigned the job of evaluating the value of the corporation's patent portfolio (represented as part of the patent information 204). In order to fully analyze the value and applicability of the corporation's patent portfolio, the user 212 must take into account other information, such as R&D information 206, financial information 216, manufacturing information 208, and licensing information 214, for both the corporation and its competitors...For this and other purposes, the present invention includes functions for automatically **analyzing the patent information** 204 in conjunction with the financial information 216.” “The invention could also be used to **determine the value of a corporate entity's patent portfolio** for purposes of a merger or acquisition. The invention could also be used in a merger or acquisition context to determine a corporate entity's business direction. For example, if Company A is interested in acquiring Company B, Company A could use the invention to categorize all of Company B's patents into groups. The nature of these groups would be an indication of the types of work that Company B is involved in.” “The present invention is capable of **automatically processing** the patents in a group, or the patents in multiple groups (alternatively, the invention can automatically process a single patent).” “Accordingly, the invention supports and **facilitates "data drilling" and/or "data mining."** (emphasis added) (excerpts from col. 10, line 11 to col. 12, line 42).

Rivette only teaches processing and analyzing data.

Rivette '751 and '767 teach against publication

As shown above, Rivette '751 and '767 teach the processing of confidential and sensitive internal documents, such as: research and development information, financial information, patent licensing information, manufacturing information, and other relevant business information

(which may, for example, include human resources information).” The present invention is a very public and accessible process. That is, the goal of the present invention is to make a product document “sufficiently accessible to one skilled in the relevant art who exercise reasonable diligence” within the meaning of 35 U.S.C. §102(b). Hence, the present invention places publications in the public domain for purposes of establishing bars to patentability.

On the other hand, the Rivette references disclose a system and method for internal use by a corporate entity as part of its decision-making process. This is the antithesis of a public and accessible process. Corporate viability and even survival require that business strategies and plans not be made accessible to competitors. Therefore, business entities go to great lengths to ensure the confidentiality and secrecy of meetings, documents, and data involved in decision-making/business plans. It is vitally important for businesses to keep such information private (not to publish such information) and in fact, there may be legal requirements to keep some of this information, such as human resource information, confidential. Thus, both Rivette references teach the opposite of the publication and public disclosure recited in Claim 11. “A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997).”

The references cited by the Examiner, considered individually and collectively, do not contain sufficient teaching, suggestion or motivation to combine/modify the references to create the present invention.

“Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.” *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987).

In the present case, the prior art references cited by the Examiner do not contain an explicit or implicit teaching, suggestion, or motivation to create the subject invention and none teach, suggest, or motivate one to combine/modify their respective teachings with others to create the subject invention.

The Examiner has cited decreasing latency in document processing as the general motivation for combining Donner with Rivette. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. However, Applicants can find no suggestion in Rivette that latency is a problem and, therefore, fail to see how latency can be a motivation to combine Donner with Rivette. Further, latency appears to be irrelevant with respect to the divergent problems addressed by Rivette, Donner, and the present invention. For example, decreasing latency will not improve the quality of the patent-centric and group-oriented data processing of Rivette or the quality of the analysis performed by Donner.

In summary, the Examiner has not provided a motivation to combine references. Likewise, the fact that a modification would be within the ordinary skill of the art is not proof of motivation *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Applicants respectfully submit that the cited prior art is only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicants' own invention characterization, not the modification of Rivette and Donner.

The Examiner states that avoiding fraud is the motivation to combine Khan with Rivette '767. Again, the Examiner fails to sufficiently explain or substantiate the statement. The present invention is not concerned with fraud and electronic signatures as is Kahn. Digital notarizing is performed in the present invention to establish a time at which a document becomes of public record. In general, Kahn is addressing a completely different set of problems and concerns than the present invention or the other references cited by the Examiner. Kahn is teaching a public portable identity. Both Rivette patents state: "A system, method, and computer program product for *processing* (emphasis added) data are described herein." (first sentence of the Abstract).

Donner teaches an intellectual property (IP) computer-implemented audit system for estimating the value of an IP folder (Abstract). Different than all the references cited by the Examiner, the present invention teaches publishing a product document to establish a bar to patentability.

Applicants also have shown that Kahn and both Rivette patents teach against the present invention.

For the reasons set forth above, Applicants respectfully submit that none of the references cited by the Examiner, considered individually and collectively, contain sufficient, teaching, suggestion, or motivation to combine or modify their teachings with those of others to create the invention claimed in Claim 11.

Rivette '767, Donner, Rivette '751, and Kahn fail to establish a *prima facie* case of obviousness with respect to Claim 11. Therefore, Claim 11 is patentable over Rivette '767, Donner, Rivette '751, and Kahn. Claims 2-10, 14-16, and 19-22, dependent from Claim 11, enjoy the same distinction from the cited references.

### **Claim 33**

Claim 33 is an apparatus claim paralleling method Claim 1. Applicants have shown that Claim 1 is patentable over the cited references. Therefore, Claim 33 also is patentable over the cited references. Claims 24-32, 36-38, and 41-44, dependent from Claim 33, enjoy the same distinction with respect to the cited references.

Applicants courteously request that the rejection be removed.

### **The Objection of Claims 13, 17, 18, 35, 39, and 40 as Being Dependent Upon a Rejected Base Claim**

Claims 13, 17, 18, 35, 39, and 40 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 11 is allowable. Therefore, Claims 13, 17, and 18, dependent from Claim 11, no longer depend upon a rejected base claim. Claim 33 is allowable. Therefore, Claims 35, 39, and 40, dependent from Claim 33, no longer depend upon a rejected base claim.




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Applicant request that the objection be withdrawn.

**Conclusion**

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Paul Maliszewski', with a large, stylized 'X' or flourish at the end.

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